

REMARKS**I. General**

Claim 32 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 21-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,283,646 to Dellert et al. (hereinafter *Dellert*).

Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 29-32 have been amended to correct informalities in their dependency. No new matter has been entered. Claims 21-32 are pending in this application.

II. Rejection under § 112, first paragraph

Claim 32 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants believe that this rejection has arisen because of a typographical error, i.e., claim 32 erroneously depended from claim 26 rather than claim 27. Accordingly, claim 32 has been amended to depend from claim 27. Claims 29-31 similarly have been amended to depend from claim 27. Thus, Applicants request that the rejection of claim 32 under 35 U.S.C. § 112, first paragraph be withdrawn.

III. Rejection under § 102(b)

Claims 21-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,283,646 to Dellert et al. (hereinafter *Dellert*).

It is well settled that to anticipate a claim, the reference must teach every element of the claim. See M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." See M.P.E.P. § 2131 (citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor*

Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989)). Applicants respectfully assert that the rejection does not satisfy these requirements.

Independent claim 21 requires generating a label having a unique identifier, wherein the unique identifier is associated with the photograph and is adapted to be affixed to a storage device that holds a printed copy of the photograph. *Dellert* does not teach “a storage device that holds a printed copy of the photograph.” Although *Dellert* discloses that a hardcopy image set and printed identification are forwarded to the user (column 10, lines 35-45), *Dellert* does not disclose that the hardcopy image set is held in a storage device.

Dellert also does not teach that “a label having a unique identifier” is generated. Although an identification signal associated with a corresponding image set signal is generated, a label having this identification signal is not disclosed as being generated. Furthermore, *Dellert* does not disclose that such a label “is adapted to be affixed to a storage device.”

Thus, *Dellert* does not teach all limitations of claim 21. Therefore, Applicants respectfully assert that claim 21 is patentable over the 35 U.S.C. § 102(b) rejection of record.

Independent claim 27 requires means for generating a label having a unique identifier, wherein the unique identifier is associated with the photograph and is adapted to be affixed to a storage device that holds a printed copy of the photograph. *Dellert* does not teach “a storage device that holds a printed copy of the photograph.” Although *Dellert* discloses that a hardcopy image set and printed identification are forwarded to the user (column 10, lines 35-45), *Dellert* does not disclose that the hardcopy image set is held in a storage device.

Dellert also does not teach that “a label having a unique identifier” is generated. Although an identification signal associated with a corresponding image set signal is generated, a label having this identification signal is not disclosed as being generated. Furthermore, *Dellert* does not disclose that such a label “is adapted to be affixed to a storage device.”

Thus, *Dellert* does not teach all limitations of claim 27. Therefore, Applicants respectfully assert that claim 27 is patentable over the 35 U.S.C. § 102(b) rejection of record.

Claims 22-26 and claims 28-32 depend from independent claims 21 and 27 respectively, and thus inherit all limitations of their respective independent claims. Each of the claims 22-26 and 28-32 set forth features and limitations not recited by *Dellert*. Thus,

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Applicants respectfully assert that for the above reason, claims 22-26 and 28-32 are patentable over the 35 U.S.C. § 102(b) rejection of record.

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.


Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003824-1 from which the undersigned is authorized to draw.


Dated: December 1, 2003

Respectfully submitted,

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 256030366 US, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 1, 2003

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